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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

HAMILTON, MONPLAISIR G

ART UNIT PAPER NUMBER

2172

DATE MAILED: 09/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/684,207

Applicant(s)

KANEVSKY ET AL

Examiner

Monplaisir G Hamilton

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-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) 35-42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) Paper No(s). <u>4</u> . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. | 6) <input type="checkbox"/> Other: _____. |

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DETAILED ACTION

1. Claims 1-42 are pending.

Election/Restrictions

2. During a telephone conversation with Paul D. Greely on 8/9/2002 a provisional election was made with traverse to prosecute the invention of Group 1, claim 1-34. Affirmation of this election must be made by applicant in replying to this Office action. Claim 35-42 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention. Claims 1-35 remain for examination.

Specification

3. The disclosure is objected to because of the following informalities: each line of the specification should be consecutively numbered on each page (pages 11-20). Appropriate correction is required.

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Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 6, 11, and 14 are rejected under 35 U.S.C. 102 (b) as being anticipated by US Patent 5991876 issued to Johnson et al, herein referred to as Johnson.

Referring to Claim 1:

Johnson discloses a method of filling an order for a right to make copies of a book (Fig 5; col 3, lines 28-45) comprising: (a) making a record for said book, said record including a plurality of the members of the group consisting of: a title of said book, a web address of a copy tracker for said book, an identity of said order, a first number of copies of said entire book that are permitted to be made, a second number of copies of pages of said book that are permitted to be made and a third number of copies of pictures of said book that are permitted to be made (Fig 5-6; col 7, lines 45-50; col 8, lines 45-50); (b) providing a user of said right with at least said web address; and (c) sending said record to said copy tracking database (col 4, lines 58-68). Elements b and c are inherent to the invention disclosed by Johnson. As disclosed by Johnson his invention is operable in a client server environment. This embodiment would require the use of

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a web address to contact the server, which hosts the order information. The limitations of b and c would therefore be anticipated as being inherent.

Referring to Claims 6 and 11:

A transaction processor for filling an order for a right to make copies of a book (Fig 5; col 3, lines 28-45) comprising: a processing unit and a memory (Fig 2); and an order procedure stored in said memory (col 4, 35-40), wherein said order procedure includes: first means for controlling said processing unit to make a record of said order (Fig 5; col 20-25), wherein said record includes a plurality of members of the group consisting of: a title of said book, a web address of a copy tracker for said book, an identity of said order, a first number of copies of said entire book that are permitted to be made, a second number of copies of pages of said book that are permitted to be made and a third number of copies of pictures of said book that are permitted to be made, and second means for controlling said processing unit to send said record to said copy tracking database (Fig 5-6; col 4, lines 58-68; col 7, lines 45-50; col 8, lines 45-50). As disclosed by Johnson his invention is operable in a client server environment. This embodiment would require the use of a web address to contact the server, which hosts the order information; these limitations would therefore be anticipated as being inherent.

Referring to Claim 14:

Johnson discloses a method of making a copy of one or more pages of a book comprising (col 8; lines 10-15): (a) determining a web address of a copy tracker for said copies of said book; (b) sending to said copy tracker a request to make said copy, said request including an identity of a right to make said copies and an identification of said pages (Fig 7); (c) obtaining from said

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copy tracker an electronic image of said pages (Fig 7; col 2, lines 9-15); and (d) making a human readable image of said electronic image (col 8, lines 10-15).

5. Claims 18-34 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 5629980 issued to Stefik et al, herein referred to as Stefik.

Referring to Claim 18, 23 and 30:

Stefik discloses a method of providing an electronic image of one or more pages of a book comprising: (a) maintaining a record of a right to make copies of said book, said record including a count process (col 4, lines 15-20; col 21, lines 10-25); (b) receiving from a user a request to make a copy of one or more pages of said book; (c) comparing said request with said record to determine if said copy is permitted; and (d) if said copy is permitted, enabling an electronic image of said copy to be presented to said user (Fig 18; col 21, lines 10-24; col 8, lines 25-30).

Referring to Claim 19, 24 and 32:

Stefik discloses the limitations as discussed in Claim 18, 23 and 31 above. Stefik further discloses a count process keeps track of copies of said book permitted by said right and of copies of said book already made, and wherein step (c) compares said request with said count process to determine if said copy is permitted (Fig 18; col 31, 50-60).

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Referring to Claim 20, 25 and 33:

Stefik discloses the limitations as discussed in Claim 19, 24 and 32 above. Stefik further discloses adjusting said count process to reflect said copy enabled by step (d) (Fig 18; col 32, lines 30-40).

Referring to Claim 21, 26 and 34:

Stefik discloses the limitations as discussed in Claim 20, 25 and 33 above. Stefik further discloses a count process includes at least one member of the group consisting of: a first number indicative of copies of the entirety of said book, a second number indicative of copies of individual pages of said book and a third number indicative of copies of individual pictures of said book, and wherein step (e) adjusts said member to reflect said copy enabled by step (d) (Fig 18; col 31, lines 50-60; col 32, lines 30-40; col 9, lines 10-15).

Referring to Claim 22, 27 and 31:

Stefik discloses the limitations as discussed in Claim 21, 24 and 30 above. Stefik further discloses a database that contains said book to serve said electronic image to said user (col 8, lines 24-30).

Referring to Claim 28:

Stefik discloses the limitations as discussed in Claim 26 above. Stefik further discloses a copy of said book stored in said memory, wherein said fourth means enables said electronic

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image to be obtained from said copy of said book stored in said memory (Fig 4, 18; col 8, lines 40-45, 55-65).

Referring to Claim 29:

Stefik discloses the limitations as discussed in Claim 28 above. Stefik further discloses preventing the presentation of said electronic image if the third means determines that said copy is not permitted (Fig 1, 18; col 31, lines 55-60).

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 2-5, 7-10, 12-13, and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson as applied to claim 1 above, and further in view of the Big Guide to Netscape Navigator, herein referred to as BNC.

Referring to Claims 2, 7, 11 and 15:

Johnson discloses the limitations as discussed in Claims 1, 6, 11, and 14 above. Johnson discloses a user interface where book information can be stored and queried (Fig 5-7).

Johnson does not expressly disclose the claimed "web address on a cover of said book."

BNC discloses the web address on the book cover (page 1).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art in to get the web address from a book. One of ordinary skill in the art would have been motivated to do this because it would provide a site to go to which would allow automated rights management and authorization (Johnson: col 3, lines 54-56).

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Referring to Claim 3 and 8:

Johnson in view of BNC discloses the limitations as discussed in Claims 2 and 7 above. BNC further discloses the web-address in machine-readable form (page 1).

Referring to Claim 4 and 9:

Johnson in view of BNC discloses the limitations as discussed in Claims 3 and 6 above. BNC further discloses identity information is on said book cover (page 1). In addition Johnson discloses an identifier that is linked to a paper reference such as an order number (col 9, lines 35-40).

Referring to Claim 5:

Johnson in view of BNC discloses the limitations as discussed in Claim 3 above. BNC further discloses the web address on one or more pages of the book (page 3, lines 8).

Referring to Claim 10, 13:

Johnson in view of BNC discloses the limitations as discussed in Claims 9 and 12 above. BNC further discloses the web address and identity on one or more pages the book (page 1; page 3, lines 8).

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Referring to Claim 16:

Johnson in view of BNC discloses the limitations as disclosed in Claim 15 above.

Johnson further discloses that the work is on a display (Fig 7; col 2 lines 10-15).

Referring to Claim 17:

Johnson in view of BNC the limitations as disclosed in claim 15 above. Johnson further discloses that the work is on a hard copy media (Fig 7; col 2 lines 10-15).

Prior Art

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent 6434535 issued to Kupka et al. Kupka discloses a system and method for distribution of electronic content over a network infrastructure and compensation of vendors of such data using prepaid media that includes a client device for operation by a user desiring to receive the electronic content and server that contains the electronic content and offering the electronic content for downloading to the client device via the network infrastructure.

US Patent 6135646 issued to Kahn et al. Kahn discloses a method of managing digital objects in a network. Holders of rights in digital objects are enabled to control terms and conditions under which they are accessed by users in a network, or are granted to others.

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US Patent 5920861 issued to Hall et al. Hall discloses a descriptive data structure provides an abstract representation of a rights management data structure such as a secure container. The abstract representation may describe, for example, the layout of the rights management data structure. It can also provide metadata describing or defining other characteristics of rights management data structure use and/or processing.

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Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monplaisir G Hamilton whose telephone number is 1703-305-5116. The examiner can normally be reached on Monday - Friday (8:00 am - 4:30 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y Vu can be reached on 1703-305-4393. The fax phone numbers for the organization where this application or proceeding is assigned are 1703-746-7239 for regular communications and 1703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 1703-305-3900.

Monplaisir Hamilton
September 19, 2002



**SHAHID AL ALAM
PATENT EXAMINER**